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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 22

Application Number: 09/545,316
Filing Date: April 07, 2000
Appellant(s): ROSS ET AL.

MAILED

MAR 05 2004

Technology Center 2100

Patric J. Rawlins
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 12/31/2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

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Appellant's brief includes a statement that claims in group A (1, 3, 5, 6, and 8, wherein claim 1 is independent claim and its dependent claim 6 stands alone (Appeal Brief, page 13)) and group B (9, 10, 11, 12, 15, 19, 20, 23, and 24, wherein claim 9 is independent claim and its dependent claims 11 and 12 are stand alone to their independent claim (Appeal Brief, page 21)) do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

6,070,177	KAO ET AL.
5,862,223	WALKER ET AL.
5,873,10	BOROVOV ET AL.
6,212,517	SATO ET AL.

Maddison et al., "Peer review", copyright 1998, pages 1-3.

Pope et al., "Using the web for peer review and publication of scientific journals", September 1998, pages 1-10.

Mathews et al., "Electronic Management of the Peer Review Process", May 6-10, 1996, pages 1-21.

Sumner et al., "Open Peer Review & Argumentation: Loosening the Pager Chains on Journals", September 1996, page 1-10.

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

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1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

(b) This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 1, 3, 5, 6, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maddison et al., "Peer review", copyright 1998, pages 1-3 in view of Pope et al., "Using the web for peer review and publication of scientific journals", September 1998, pages 1-10, Mathews et al., "Electronic Management of the Peer Review Process", May 6-10, 1996, pages 1-21, Kao et al., US 6,070,177 filed 03/1998, Sumner et al., "Open Peer Review & Argumentation: Loosening the Pager Chains on Journals", September 1996, page 1-10, Walker et al., U.S. 5,862,223 filed 07/1996, and Borovoy et al., US 5,873,107 filed 03/1996.

Regarding independent claim 1, Maddison teaches the steps of:

- assigning a qualified reviewer to the article (Maddison, page 2, lines 26-30, teaches that the step of assigning reviewers to review the article based on the reviewers' expertise and the subject of the article).
- providing an evaluation form to the reviewer (Maddison, page 2, lines 35-37);

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- receiving a completed evaluation from the reviewer (Maddison, page 2, lines 35-37 and page 3, line 1, teaches “the reviewer typing comments ... evaluation form” and “the comments furnished ...”);
- providing the completed evaluation form to the author (Maddison, page 2, lines 27-29 and 33, teaches “the reviewer typing comments ... evaluation form” and “the comments furnished by the reviewer are passed along to the author”);
- receiving a response from the author (Maddison, page 3, lines 1-7, teaches that the author responses to the reviewers when the author decline to make the requested changes from the reviewer);
- providing the author responses to an editor (Maddison, page 3, lines 1-7, teaches that the editors consider the author response); and
- receiving a publication decision from the editor (Maddison, page 2, lines 8-10 and 16-17, pages are marked with peer review icon is the version ready to be publish; page 3, lines 3-11, teaches that “page is awarded the peer review mark once authors have made all the changes and additions *required by the editor*).

Maddison does not explicitly teaches receiving an article from an author via communication network; querying a database of potential reviewers to determine a qualified reviewer; receiving a response from the author directly in the completed evaluation form; providing the completed evaluation with author responses to an editor; and providing the publication decision to the author and the review.

Pope teaches the steps of:

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- receiving an article from an author via a communication network (Pope, page 2, lines 28-31, teaches the step of using the network to submit an article to a journal).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Pope and Maddison to make Maddison's peer review process on-line, as Maddison disclosed "reviews are usually conducted on-line" (page 2, line 35), as Pope disclosed "made it possible to conduct the entire peer-review process on-line" (page 1, lines 6-7).

However, Pope does not explicitly disclose the steps of querying a database of potential reviewers to determine a qualified reviewer; receiving a response from the author directly in the completed evaluation form; providing the completed evaluation with author responses to an editor; and providing the publication decision to the author and the review.

Mathews teaches peer review process includes the steps of:

- providing an evaluation form to the reviewer (Mathews, page 3, lines 33-35 and page 7, lines 22-33, providing an evaluation form which includes several criteria rating and comments field to the reviewer);
- receiving a completed evaluation form from the reviewer (Mathews, page 3, lines 33-35 and page 7, lines 22-33; the score and the comments are mailed to the author);
- providing the completed evaluation form to the author (Mathews, page 3, lines 33-35 and page 7, lines 22-33; the score and the comments are mailed to the author); and
- providing the publication decision to the author and the reviewer (Mathew, page 8, lines 25-37, teaches that the publication decision is inform to the author via email, and the reviewers can examine the report of the decision).

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It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Mathews into Maddison and Pope to provide the announcement of the result for the authors as well as the reviewers, since in the business practice, both the reviewers and the authors are people who expect the result.

However, Mathews does not explicitly disclose the steps of querying a database of potential reviewers to determine a qualified reviewer; receiving a response from the author directly in the completed evaluation form; and providing the completed evaluation with author responses to an editor.

Kao teaches a form is transmitted among several user to review includes comments which are entered directly in the form (Kao, col.5, lines 8-10; col.6, lines 17-40; and fig.4).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Kao into Maddison, Pope and Mathews to allow the author responses to the reviewers evaluation form directly in the completed evaluation form and providing the completed evaluation with author responses to an editor to facilitate the peer review process, since this would have helped the reviewers, authors, and editor are able to use the evaluation form to communicate to each other in peer review conducted on-line.

However Kao does not explicitly disclose the steps of querying a database of potential reviewers to determine a qualified reviewer.

Sumner teaches, "automated systems are in place for matching reviewers with submissions based on keyword analysis" (Sumner, page 2, lines 7-8); and "the editor then decides whether the article should be accepted ... for publication with the final article (Sumner, page 7, line 13 – page 8, line 2).

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It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Sumner into Maddison, Pope, Mathew, and Kao to provide an automated system to determine a qualified reviewer for an article based on keyword analysis, since this would have facilitate the peer review process.

However, Sumner does not explicitly disclose the step of querying a database of potential reviewers to determine a qualified reviewer.

Walker teaches the step of:

- querying a database of potential reviewers to determine a qualified reviewer (Walker, col.7, lines 32-61).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Walker's search program to identify qualified experts into Maddison, Pope, Mathews, Kao and Sumner's peer review process to provide a way to find a qualified reviewer to review the article as Walker disclosed "a simple way for users to find qualified experts to give them professional advice" (Walker, col.7, lines 1-5).

Borovoy teaches the step of:

- extracting context information from the article (Borovoy, col.2, line27-28)
- query a database based on the extracted context information (Borovoy, col.2, lines 29-30)

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Borovoy's teaching into Walker's to provide the steps of query a database for potential reviewers based on the context information extracted from the article since this would have facilitated queries for potential reviewers in the peer review

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process; as Summer discloses “automated systems are in place for matching reviewers with submissions based on keyword analysis” (Sumner, page 2, lines 7-8). This would have further realized Pope teaching to “make it possible to conduct the entire peer-review process on-line” (page 1, lines 6-7).

Regarding dependent claim 3, which is dependent on claim 1, Maddison, Pope, Mathews, Kao, Sumner, Walker, and Borovoy teach the limitations as explained above. Walker teaches that the qualified reviewer is determined according to availability and past performance, including, experience, availability criteria, response time, prior work history, skill sets, prior work history (Walker, col.14, line 66 – col.15, line 7; col.17, lines 44-53; and col.41, claim 3).

Walker does not explicitly state “timeliness, thoroughness, clarity, and the number of completed reviews” criteria are use to determine the qualified reviewer.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Walker’s criteria for a qualified expert which includes “timeliness, thoroughness, clarity, and the number of completed reviews” because Walker’s criteria for a qualified expert, such as “response time, experience, skill sets, and prior work history” suggest “timeliness, thoroughness, clarity, and the number of completed reviews” criteria becomes conditions for searching an expert for reviewing a particular article.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Walker into Maddison, Pope, Mathews, Kao, Sumner to find a potential reviewer among others to review the particular article, since it would have provide proper evaluation for the article.

Regarding dependent claim 5, which is dependent on claim 1, Maddison, Pope, Mathews, Kao, Sumner, Walker, and Borovoy teach the limitations as explained above. The limitation of “receiving comments entered directly into the evaluation form” is addressed under the same rationale as provided above in the rejection of claim 1.

Regarding dependent claim 6, which is dependent on claim 1, Maddison, Pope, Mathews, Kao, Sumner, Walker, and Borovoy teach the limitation of claim 1 as explained above. Maddison does not explicitly disclose the steps of automatically reformatting the article into a standard format and presenting the formatted article to the author for approval.

Pope also teaches the steps of:

- automatically reformatting the article into a standard format (Pope, page 3, lines 1-27, teaches that the software “mounts an HTML version of the complete article”).
- presenting the final version article to the author for approval (Pope, page 7, lines 7-9).

However, Pope does not explicitly disclose presenting the *reformatted article* to the author for approval.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have including the step of presenting the reformatted article to the author for approval in a peer review process because Pope teaches presenting the *final version article* to the author for approval, which suggests the reformatted article is also approved by the author to reduce mistakes or any improper from the reformat process.

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It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Pope into Maddison, Mathews, Kao, Sumner, Walker, and Borovoy to make a peer review process on-line applicable to any type of journal publication, since “reformat into a standard format” would have helped different kind of journals converts the submitted article to satisfy the format requirements.

Regarding dependent claim 8, which is dependent on claim 1, Maddison, Pope, Mathews, Kao, Sumner, and Walker teach the limitations as explained above. Refer to the rationale relied to reject claim 1, the step of “informing the author of the publication decision by email” is addressed. The rationale is incorporated herein.

3. Claims 9-12, 15, 19-20, 23, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pope et al., “Using the web for peer review and publication of scientific journals”, September 1998, pages 1-10, in view of Maddison et al., “Peer review”, copyright 1998, pages 1-3, Mathews et al., “Electronic Management of the Peer Review Process”, May 6-10, 1996, pages 1-21, Kao et al., US 6,070,177 filed 03/1998, Sumner et al., “Open Peer Review & Argumentation: Loosening the Pager Chains on Journals”, September 1996, page 1-10, Walker et al., U.S. 5,862,223 filed 07/1996, and Borovoy et al., US 5,873,107 filed 03/1996.

Regarding independent claim 9, Pope teaches the steps of:

- receiving an article from an author via a communications network (Pope, page 2, lines 28-31, teaches the step of using the network to submit an article to a journal);

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- receiving an agreement from one or more qualified reviewers (Pope, page 5, lines 1-4, teaches the software keeps track of “who has agreed to review” and “who has not yet responded the request”, which implies one or more qualified reviewers responses the request for agreement); and
- contacting each qualified reviewer and requesting that the qualified reviewer agree to review the article (Pope, page 5, lines 1-8, teaches the software contacts the required number of reviewers).

Pope does not teach the steps of searching a database of potential reviewers; generating a ranked list of qualified reviewer; providing the article to an accepting qualified reviewer; providing an evaluation form to the accepting qualified reviewer; receiving a completed evaluation form from the accepting qualified reviewer; providing the author with the completed evaluation form; receiving a response from the author directly in the completed evaluation; providing the completed evaluation form with author response to an editor; receiving a publication decision from the editor; and providing the publication decision to the author and the reviewer.

Maddison teaches the steps of:

- providing an evaluation form to the accepting qualified reviewer (Maddison, page 2, lines 35-37);
- receiving a completed evaluation form from the accepting qualified reviewer (Maddison, page 2, lines 35-37 and page 3, line 1, teaches “the reviewer typing comments ... evaluation form” and “the comments furnished ...”);

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- providing the author with the completed evaluation form (Maddison, page 2, lines 27-29 and 33, teaches “the reviewer typing comments ... evaluation form” and “the comments furnished by the reviewer are passed along to the author”);
- receiving a response from the author (Maddison, page 3, lines 1-7, teaches that the author responses to the reviewers when the author decline to make the requested changes from the reviewer);
- providing the author responses to an editor (Maddison, page 3, lines 1-7, teaches that the editors consider the author response); and
- receiving a publication decision from the editor (Maddison, page 2, lines 8-10 and 16-17, pages are marked with peer review icon is the version ready to be publish; page 3, lines 3-11, teaches that “page is awarded the peer review mark once authors have made all the changes and additions *required by the editor*).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Maddison and Pope to provide the advantages of peer review process online, since both Maddison and Pope’s purpose is “conduct the entire peer review process online” as Pope disclosed on page 1, lines 6-7. As Maddison disclosed, “Reviews are usually conducted on-line” (Maddison, page 2, lines 26).

However, Maddison does not explicitly disclose the steps of searching a database of potential reviewers; generating a ranked list of qualified reviewer; providing the article to an accepting qualified reviewer; receiving a response from the author directly in the completed evaluation; providing the completed evaluation form with author response to an editor; receiving

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a publication decision from the editor; and providing the publication decision to the author and the reviewer.

Mathews teaches peer review process includes the steps of:

- providing an evaluation form to the reviewer (Mathews, page 3, lines 33-35 and page 7, lines 22-33, providing an evaluation form which includes several criteria rating and comments field to the reviewer);
- receiving a completed evaluation form from the reviewer (Mathews, page 3, lines 33-35 and page 7, lines 22-33; the score and the comments are mailed to the author);
- providing the completed evaluation form to the author (Mathews, page 3, lines 33-35 and page 7, lines 22-33; the score and the comments are mailed to the author); and
- providing the publication decision to the author and the reviewer (Mathew, page 8, lines 25-37, teaches that the publication decision is inform to the author via email, and the reviewers can examine the report of the decision).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Mathews into Maddison and Pope to provide the announcement of the result for the authors as well as the reviewers, in the business practice, both the reviewers and the authors are people who expect the result.

However, Mathews does not explicitly disclose the steps of searching a database of potential reviewers; generating a ranked list of qualified reviewer; providing the article to an accepting qualified reviewer; receiving a response from the author directly in the completed evaluation; providing the completed evaluation form with author response to an editor; and receiving a publication decision from the editor.

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Kao teaches a form is transmitted among several user to review includes comments which are entered directly in the form (Kao, col.5, lines 8-10; col.6, lines 17-40; and fig.4).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Kao into Pope, Maddison, and Mathews to allow the author responses to the reviewers evaluation form directly in the completed evaluation form and providing the completed evaluation with author responses to an editor to facilitate the peer review process, since this would have helped the reviewers, authors, and editor are able to use the evaluation form to communicate to each other in peer review conducted on-line.

However Kao does not explicitly disclose the steps of searching a database of potential reviewers; generating a ranked list of qualified reviewer; and providing the article to an accepting qualified reviewer.

Sumner teaches, “automated systems are in place for matching reviewers with submissions based on keyword analysis” (Sumner, page 2, lines 7-8); and “the editor then decides whether the article should be accepted ... for publication with the final article (Sumner, page 7, line 13 – page 8, line 2).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Sumner into Pope, Maddison, Mathews, and Kao to provide an automated system to determine a qualified reviewer for an article based on keyword analysis, since this would have facilitate the peer review process.

However, Sumner does not explicitly disclose the step of searching a database of potential reviewers; generating a ranked list of qualified reviewer; and providing the article to an accepting qualified reviewer.

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Walker teaches the steps of:

- searching a database of potential reviewers (Walker, col.7, lines 32-61; col.17, lines 43-45; and col.20, lines 32-35, teaches searching the database to generate a list of qualified reviewers);
- ranking the plurality of qualified reviewers (Walker, col.25, lines 35-44, teaches displaying a rated list of qualified expert, “expert qualification levels is display ... Once a level of expertise has been selected ... a list of expert Ids is display ... rating for that expert may be available); and
- providing the article to an qualified reviewer (Walker, col.9, lines 40-50).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Walker’s search program to identify qualified experts into Maddison, Pope, Mathews, and Sumner’s peer review process to provide a way to find a qualified reviewer to review the article as Walker disclosed “a simple way for users to find qualified experts to give them professional advice” (Walker, col.7, lines 1-5) as well as to improve peer review process by Walker’s search program to generate “a *prioritized* list of potential reviewers” as Pope disclosed on page 4, lines 8-10.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the step of *providing the article to an accepting qualified reviewer* in Pope, Maddison, Mathews, Kao, Sumner’s peer-review process as Mathews disclosed “ ... a reviewer to view or print the entire paper ... ” (Mathews, page 6, line 8) after the author submitted the article, since it is impossible for a qualified reviewer to review/evaluate an article without see its content.

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Borovoy teaches the step of:

- extracting context information from the article (Borovoy, col.2, line27-28)
- query a database based on the extracted context information (Borovoy, col.2, lines 29-30)

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Borovoy's teaching into Walker's to provide the steps of query a database for potential reviewers based on the context information extracted from the article since this would have facilitated queries for potential reviewers in the peer review process; as Summer discloses "automated systems are in place for matching reviewers with submissions based on keyword analysis" (Sumner, page 2, lines 7-8). This would have further realized Pope teaching to "make it possible to conduct the entire peer-review process on-line" (page 1, lines 6-7).

Regarding dependent claim 10, which is dependent on claim 9, Pope, Maddison, Mathews, Kao, Sumner, Walker, and Borovoy teach the limitation as explained above. Refer to the rationale relied to reject claim 9, the limitation of "the accepting qualified reviewers complete the evaluation form online" is addressed. As Pope disclosed "made it possible to conduct the entire peer-review process on-line" (Pope, page 1, lines 46-7).

Regarding dependent claim 11, which is dependent on claim 9, Pope, Maddison, Mathews, Kao, Sumner, Walker, and Borovoy teach the limitation as explained above. Pope does not teaches that each accepting qualified reviewer for an article has access to completed

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evaluation forms of other accepting qualified reviewers after submitting an evaluation form for the same article.

Mathews teaches the reviewers are able to access to the Web site to update the reviews or examine submissions (Mathews, page 7, lines 19-20, “every paper must be reviewed by at least two reviewers”; and page 17, lines 15-21, “reviewers with limited access (update reviews, examiner submissions, etc)).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Mathews and Pope to provide the reviewers a level degree access, such as the reviewers are able to access other evaluation forms, since this would have allowed the reviewer to know other evaluation opinion on the same article.

However, Mathews does not explicitly disclose accessing other completed evaluation form after submitting an evaluation form for the same article.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have appreciated that the reviewer has access to completed evaluation forms of other accepting qualified reviewers after submitting an evaluation form for the same article to provide honesty evaluation, since examining other completed evaluation form for the same article before evaluate and submit it would have influenced the reviewer’ point of view in evaluating process.

Regarding dependent claim 12, which is dependent on claim 9, Pope, Maddison,

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Mathews, Kao, Sumner, Walker, and Borovoy teach the limitation as explained above. Pope does not explicitly disclose that each accepting qualified reviewer can set access privileges for a section of the reviewer's completed evaluation form.

Maddison teaches that each accepting qualified reviewer have the option of revealing their identity or not to the author (Maddison, page 2, lines 30-34). Maddison does not explicitly teach that each reviewer can "set access privilege for a section of the reviewer's completed evaluation form". However, the ability to "set access privilege for a section of the reviewer's completed evaluation form" would have been obvious to one of ordinary skill in the art at the time the invention was made, in view of Maddison, because Maddison teaches that the reviewers have "option of revealing their identity" or not to the authors, which suggest the ability to set any type of confidential information should be protected in order to evaluate the article to the author, providing integrity of work.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Maddison and Pope to increase the accuracy of the information presented in the article, protect the reviewers privacy and objectivity, since "setting confidential for sections of the reviewer's completed form" would have helped the reviewers openly evaluate the article.

Regarding dependent claim 15, which is dependent on claim 9, Pope, Maddison, Mathews, Kao, Sumner, Walker, and Borovoy teach the limitation of claim 9 as explained above. Pope also teaches that reformatting the article into a standard format (Pope, page 3, line 1-26,

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Pope teaches that “the above formatting provisions allow the software to: mounts an HTML version of the complete article”).

Regarding dependent claim 19, which is dependent on claim 9 Pope, Maddison, Mathews, Kao, Sumner, Walker, and Borovoy teach the limitation of claim 9 as explained above. Pope teaches that the article iterates through the peer review process until the article is approved for publication (Pope, page 1, lines 1-12).

Regarding dependent claim 20, which is dependent on claim 19, Pope, Maddison, Mathews, Kao, Sumner, Walker, and Borovoy teach the limitation of claim 19 as explained above. Pope teaches that after the article has been approved for publication, further comprising the steps of:

- creating a galley proof of the article (Pope, page 7, lines 7-12);
- providing the galley proof of the author (Pope, page 7, lines 7-12);
- receiving an approval of the galley proof from the author (Pope, page 7, lines 7-12);
- and
- immediately publishing the article in electronic format (Pope, page 7, lines 7-12).

However, Pope does not teach proving the galley proof to the *editor* for an approval.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have included the step of proving the galley proof to the editor for an approval before publishing the article to increase the accuracy of the information presented in the article, since both the author and the editor are people who has knowledge/experience with the

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article. As Pope disclosed, "Once the reviews are submitted, the subject editors has made a recommendation" (Pope, page 6, line 11).

Regarding dependent claim 23, which is dependent on claim 9, Pope, Maddison Mathews, Kao, Sumner, Walker, and Borovoy teach the limitations as explained above. Pope teaches receiving an article from an author via a communication network (Pope, page 2, lines 28-31, teaches the step of using the network to submit an article to a journal).

Pope does not explicitly disclose receiving a co-authored article.

Maddison teaches peer review process in which authors work on a book (Maddison, page 1, lines 10-17).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Maddison and Pope to facilitate the peer review process when the big project, such as journal or Madison's book is working on, which need many author's knowledge, since the entire Maddison's peer review process on-line, the co-authors are more convenient to contact each other as well as submit a part of article or respond to the reviewers.

Regarding dependent claim 24, which is dependent on claim 23, Maddison, Pope, Mathews, Walker, and Borovoy teach the limitations as explained above. Pope does not explicitly disclose the step of receiving a response from each co-author directly in the completed evaluation form. Refer to the rejection of claim 9, Pope in view of Maddison, Mathews, and Kao

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teach “receiving a response from the author directly in the completed evaluation form” as explained above.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Maddison into Pope, Mathews, and Kao to facilitate the peer review process as well as communication between reviewers and co-author, since all co-authors and reviewers are able to access to the evaluation form.

4. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Maddison in view of Pope, Mathews, Kao, Sumner, Walker, and Borovoy as applied to claim 3 above, and further in view of Sato et al., US 6,212,517 B1 filed 06/1998.

Regarding dependent claim 4, which is dependent on claim 3, Maddison in view of Pope, Mathews, Kao, Sumner and Walker teach the limitation of claim 3 as explained above. Maddison does not disclose the steps of generating a ranked list of keywords related to the article; providing the list of keywords to the author; and receiving an approval of the ranked list from the author.

Sato teaches the steps of:

- generating a ranked list of keywords related to a selected document/text (Sato, col.1, lines 9-11 and 53-61; and col.8, lines 16-20); and
- providing the list of keywords to the user (Sato, col.1, lines 9-11, “providing a list of keywords ranked”).

It would have been obvious to a person of ordinary skill in the art at the time the

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invention was made to have modified Sato and Pope to provide keyword information to the author as Pope disclosed “create ... keywords ... information ... for use in messages to authors” (Pope, page 3, lines 23-24).

However, Sato does not disclose the step of receiving an approval of the ranked list from the author.

Pope teaches the step of:

- receiving an approval of the *final version article* from the author (Pope, page 7, lines 7-9).

However, Pope does explicitly disclose receiving an approval of the *ranked list* from the author.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have including the step of presenting the *ranked list* of keywords to the author for approval in a peer review process because Pope teaches presenting the *final version article* to the author for approval, which suggests the *ranked list* is also approved by the author to reduce mistakes or any improper from ranking process.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Pope and Sato into Maddison, Mathews, Kao and Walker to make a peer review process on-line more accurate, since both system and author agree the article content based on ranked list of keywords.

5. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pope in view of

Maddison, Mathews, Kao, Sumner, Walker, and Borovoy as applied to claim 9 above, and further in view of Sato et al., US 6,212,517 B1 filed 06/1998.

Regarding dependent claim 16, which is dependent on claim 9, Pope in view of Maddison, Mathews, Kao, Sumner, and Walker teach the limitation of claim 9 as explained above. Refer to the rejection of claim 9, in which “searching the database to generate a list of qualified reviewers” is addressed. The rationale is incorporated herein.

Pope does not explicitly disclose the steps of parsing the title and text of the article to generate a list of keywords; and ranking the list of keywords according to their relative weight in describing the content of the article.

Sumner teaches that “Sometimes, automated systems are in place for matching reviewers with submission based on keyword analysis” (Sumner, page 2, lines 7-8), which implies the step of parsing the article, such as the title, abstract, and text content to find article’s keywords for matching the reviewer records.

However, Sumner does not teach the step of ranking the list of keywords according to their relative weight in describing the content of the article.

Sato teaches the step of ranking the list of keywords according to their relative weight in a selected document/text (Sato, col.1, lines 19-11 and 53-61; and col.8, lines 16-20).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Sato and Sumner to provide more clearly the main content of the submitted article, since article’s keywords are provided “in order of importance”.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Sumner and Sato into Pope, Maddison, Mathews, Kao,

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Walker to provide an automatically selection of potential reviewers to review the particular submitted article based on the keywords which are parsed from the submitted article, as Maddison disclosed “ the major criterion for the selection of potential reviewers is their scholarly expertise as demonstrated by their publication record on the organisms represented on the page to be reviewed” (Maddison, page 2, lines 28-30). As Pope disclosed on page 3, lines 17-25, “create ASCII versions of acknowledgments, abstract, keywords, ...” after the authors submit their articles.

(11) *Response to Argument*

“Whether claims 1, 3, 5, 6, and 8 are patentable under 35 U.S.C. 103 over the combination of (1) Maddison; (2) Pope; (3) Mathews; (4) Kao; (5) Sumner; (6) Walker; and (7) Borovoy”

On page 6 of the Appeal Brief, Appellants argue that Maddison fails to teach the completed evaluation form is provided to the author, as required by claim 1.

Examiner disagrees. Although Maddison does not explicitly state that the completed evaluation form is provided to the authors. He clearly teaches that the reviews do relate to “individual sections of a contribution” and they are typed into “windows of a structured evaluation form”. The reviews (comments) are then “passed along to the authors”. These strongly suggest that the completed review form is provided to the author. Otherwise, the “structure” of the reviews would not be kept the same. Moreover, the reviews alone would no longer refer to the “individual sections” of the contribution. If these are the case, the author would be confused about what reviews (comments) belong to what sections.

On page 7 to page 8 of the Appeal Brief, Appellants argue that Maddison fails to teach the response from the author are received directly in the completed evaluation form, as required by claim 1.

Examiner agrees. Maddison teaches, “receiving a response from the author” (Maddison, page 3, lines 1-7, teaches that the editors consider the author response). As discussed in the Final Action, as well as acknowledge by the appellants, Maddison does not explicitly disclose the author’s responses are directly in the completed evaluation form.

However, the combination of Kao and Maddison teaches this feature. Kao teaches an on-line form is transmitted among several user to review includes comments which are entered directly in the form (Kao, col.5, lines 8-10; col.6, lines 17-40; and fig.4).

On page 8 to page 9 of the Appeal Brief, Appellants argue that Maddison reference does not expressly teach and does not fairly suggest providing the completed evaluation form with author responses to an editor”.

Examiner disagrees. As discussed above, Maddison teaches the completed review form is provided to the author; and the combination of Maddison and Kao teaches the completed evaluation form that including the reviewer’s comment and the author’s response.

Maddison teaches on-line peer review process requires opinions of author, reviewer, and editor, that includes providing the author responses to an editor (Maddison, page 3, lines 1-7, teaches that the editors consider the author response). Note that Kao teaches using an on-line form that “requires circulation among different personnel or user in computer network” (Kao,

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col.7 lines 57-64) and comments/opinions are entered directly in the form (Kao, col.5, lines 8-10; col.6, lines 17-40; and fig.4). A combination of Maddison and Kao therefore suggests that the author responses in the form are provided to the editor.

On page 9 to page 11 of the Appeal Brief, Appellants argue that Mathews does not teach or suggest the completed evaluation form is provided to the author, as required by claim 1.

Examiner disagrees. As stated above, Maddison already strongly suggest that the completed evaluation form is provided to the author in order to keep the structure and relationships among the reviews and related sections of contribution. Here Mathews also suggest that the reviewers' comments and scores are to be sent with the sections of the paper (laid out by the evaluation form) so to facilitate understanding of the various scores assigned and the refereeing process. Although not explicitly taught, any ordinary skilled in the art at the time the invention was made would clearly see the necessity, as suggested by Maddison and Mathews, to keep individual reviews in relationship with sections of the paper; as they are typed in by reviewer, thus the necessity to send the exact review (or evaluation) form along to the authors.

“Prima Facia Obviousness Not Met for Claim 1”

On page 11 of the Appeal Brief, Appellants argue that “the tenuous seven (7) way obviousness rejection of independent claim 1 fails to make a prima facie case of obviousness because no motivation to combine the seven (7) references has been identified in the Final Action”.

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Examiner respectfully disagrees. Although using 7 prior arts, these prior arts all relate and benefit to reviewing process. Four of them (Maddison, Pope, Mathews, Sumner) directly teach methods to let reviewers evaluate articles in a peer review process on-line, two others (Walker and Borovoy) teach database of potential reviewers to determine a qualified reviewer, and the last one (Kao) teaches reviewing and approving data or document using form on-line. Since these prior arts all relate, any ordinary skill in the art at the time the invention was made would have been motivated to look up, modify and combine them to take advantages of their strengths and come up with what claimed by Appellants.

Appellants further argue on page 12 last paragraph of the Appeal Brief that, “Kao fails to disclose in any reason, suggestion, motivation or teaching to combine its database form audit history to peer review of the articles”.

Examiner disagrees. Kao teaches a method to pass an on-line form along different users to facilitate communications among them. This includes giving approvals, comments, etc. on any actions and services that deem necessitate (Kao, col.7 lines 57-64, “It should be noted that many other forms for various application may be used in conjunction with the audit trail in accordance with the embodiments of the present invention ... include supply requests, ... and any other form or document that requires circulation among different personnel or user in computer network”). Kao’s teaching is therefore similar to Maddison and Mathews’ method of collecting reviews/comments among different users and passing them along as needed. Besides, there is no technical reason why a combination of Kao into Maddison/Mathews is not doable. In facts, any ordinary skilled in the art at the time the invention was made would have modified and

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combined Kao into Maddison to further facilitate inputs from various parties involved in the peer reviewing tasks.

“Claim 6 stands alone”

On page 13 of the Appeal Brief, Appellants argue with respect to claim 6 that “examiner’s reading of what is taught or suggest in Pope appears to be based on hindsight gleaned from the benefit of reading Appellants disclosure rather than on the fair teachings of the reference” for “reformatting the article into a standard format and then presenting the reformatted article to the author for approval”.

Examiner respectfully disagrees. Pope teaches peer-review process and “made it possible to conduct the entire peer-review process on-line” (Pope, first page, last sentence of first paragraph). As discussed in the Final Action, Pope teaches that the automated submission module software reformats the submitted article into a standard format HTML at a password-protected review site (Pope, page 3, teaches in “the automated submission module” that the software “mounts an HTML version of the complete article ... at a password-protected review site”). The software creates a text file of acknowledgments for use in messages to authors and contacts the author for an acknowledgement of receipt of the article (Pope, page 3, “the automated submission module” section, “create ASCII version of acknowledgments ... send an acknowledgement of receipt of the article to the author”). Further, Pope teaches reformatted HTML version (final version) is presented at the password-protected review site to the author for approval (Pope, page 7, first and second paragraph, presenting of information in the HTML document version (final version) for the authors approval, “the authors contacted to approve the

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on-line proofs (still at the password protected review site)). This highly suggests the authors are allowed to access the password-protected review site to verify their reformatted submission articles, which are reformatted in HTML format at the protected review site as claimed “automatically reformatting the article into a standard format and presenting the reformatted article to the author for approval”.

It is noted that Appellants do not specify that the reformatted article is presented to the author for approval before sending the article to a reviewer. Thus, Appellants’s argument, “the advantages of a standard format and quality review[ed] by the author prior to sending the article to a reviewer are numerous and specifically include the insurance that the article is ultimately provided to ... allowing an author to approve the reformatted article at this point in the process facilitates the initial review and makes the entire review process more efficient” (Appeal Brief, page 13, second paragraph) for claim 6 is not considered. Pope teaches exactly what appellants claimed, “automatically reformatting the article into a standard format and presenting the reformatted article to the author for approval”.

“Whether claims 9, 10, 11, 12, 15, 19, 20, 23, and 24 are patentable under 35 U.S.C. 103 over the combination of (1) Pope; (2) Maddison; (3) Mathews; (4) Kao; (5) Sumner; (6) Walker; (7) and Borovoy”

From page 14 to page 21, Appellants’ argues with respect to claim 9 is similar to arguments from page 6 to 12 with respect to claim 1. Please refer to the response to argument of claim 1 above.

“Claims 11 and 12 stand or fall together”

On page 21 to page 22 of the Appeal Brief, Appellants argue with respect to claims 11 and 12 that “examiner’s reading of what is taught or suggest in Mathews appears to be based on hindsight gleaned from the benefit of reading Appellants disclosure rather than on the fair teachings of the reference” for “allowing a reviewer to gain access to reviews of the same article that were completed by other co-reviewers”.

As explained in the Final Action, Mathews teaches the reviewers are able to access to the Web site to update the reviews or examine submissions (Mathews, page 7, lines 19-20, “every paper must be reviewed by at least two reviewers”; and page 17, lines 15-21, “reviewers with limited access (update reviews, examiner submissions, etc)).

Mathews also teaches creating different levels degree access for each user (Mathews, page 17, lines 15-29, authors, reviewers, administrator). Mathews specifies that after submitting evaluations, all reviewers can examine a report based on the evaluations to determine a need for re-evaluation of a particular paper (Mathews, page 8, lines 25-30). These highly suggest that a reviewer can examine other reviewer’s evaluation.

“Whether claim 4 is patentable under 35 U.S.C. 103 over the combination of (1) Maddison; (2) Pope; (3) Mathews; (4) Kao; (5) Sumner; (6) Walker; (7) Borovoy; and (8) Sato”

On page 22 to page 23 of the Appeal Brief, Appellants argue with respect to claim 4 that “examiner’s reading of what is taught or suggest in Mathews appears to be based on hindsight gleaned from the benefit of reading Appellants disclosure rather than on the fair teachings of the

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reference” for “upon receipt of an article from an author, a ranked list of keywords related to the article is generated, the ranked list of the keywords is provided to the author, and the author approves the ranked list of keyword”.

Examiner disagrees. As explained in the Final Action, Sato teaches generating a ranked list of keywords related to a document/text and proving the list of keywords to the user display.

Pope teaches creating a list of keywords and sending to authors, editors and reviewers (Pope, page 3, lines 6-7 from the bottom, “create ASCII version of ... keywords, ... for use in messages to authors, editors, and reviewers”). This means besides other things, a list of keywords must be generated and approved by the authors and others

Please note that in additional support of the present rejection, Pope teaches after receiving a submission from the author, submission module software creates an HTML version of the article (Pope, page 3, lines 10) and a list of keywords (Pope, page 3, lines 6-7). Pope further teaches editing information in the article including the keywords (Pope, page 8, lines 2-5 “editor works on an html version ... Information such as ... title, keywords ... is edited ...”). Note that title, abstract, keywords are parts of the article (see Pope, page 3, lines 9-10, “ “Tag” must be insered to dentify parts of the article (eg. Tilte, abstract, keywords, ...”)); and authors are to approve the article in html version on-line (Pope, page 7, lines 7-8). These highly suggest that a list of keywords from the article are approved by the author.

“Whether claim 16 is patentable under 35 U.S.C. 103 over the combination of (1) Pope; (2) Maddison; (3) Mathews; (4) Kao; (5) Sumner; (6) Walker; (7) Borovoy; and (8) Sato”

On page 23 of the Appeal Brief, Appellants argue with respect to claim 16 that “what Sumner does not expressly teach or disclose is how the keywords are generated. Sumner does not teach or suggest that the keywords are generated by parsing the title and text of the article, as required by claim 16”.

Examiner disagrees. Sumner teaches matching reviewers with submissions based on keyword analysis (Sumner, page 2, lines 4-9). Since the author submits an article for review including article text, topic, title (see Mathews’ figure on page 16), generating keywords for best information describing the article from the text of article, topic and title is highly suggested.

It is noted that Sato teaches generating a ranking list according to their relative weight in a selected document/text (Sato, col.1, lines 19-11 and 53-61; and col.8, lines 16-20) wherein the degree of importance (weight) of text/word depends on where the text/word exists, such as from the title, subtitle or the body of the document (Sato, col.10, lines 21-33). These highly suggest that the keywords are generated from the text of article (body) and title.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

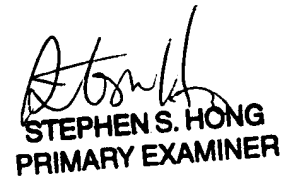
TVH

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